

USSN 10/713,102
KAWASE *et al.*REMARKSRECEIVED
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Claims 13, 15, 19-22 and 24 are presented for examination. Claims 13, 19-22 and 24 are currently amended and claims 1-12, 14, 16-18 and 23 canceled. Claim 15 is pending as previously presented.

The Examiner allowed claim 17, which corresponds to pending claim 13. Pursuant to an Interview of October 10, 2006, it was admitted that claims 13 and 15 would both be allowable if amended to overcome the outstanding indefiniteness rejections given that there is no prior art rejections for these claims. That indication is acknowledged with appreciation and the claims have been amended to place them into condition for allowance.

Amended claim 13 recites the limitation of the reactive monomer (B) in proper Markush format to overcome the indefiniteness rejection. Amended claims 19-22 and 24 properly depend from either claim 13 and 15. Support for the amendments can be found in the claims themselves. No new matter within the meaning of § 132 has been incorporated by the amendments.

Accordingly, a timely Notice of Allowance is requested.

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1. Objection to Claims

The Office Action objected to claims 16 and 18-24 as being in improper multiple dependent form because a multiple dependent claim can only depend upon other claims in the alternative. The rejection is traversed because the claims 16 and 18-24 recite other claims as limitations. However, claims 16, 18 and 23 are canceled; and claims 19-22 and 24 have been amended to properly depend upon claims 13 and 15 in the alternative. Hence, the objection is moot.

2. Rejection of Claims under 35 U.S.C. § 112, ¶ 2

The Office Action rejected claims 13 and 15 as being indefinite. The Office Action stated:

It is unclear from the language as found in amended claim 13 what monomers (A) and (B) are. It would appear, for instance that 3-methacryloxypropyltrimethylsilane is (A) but the use of "and/or" before the next two silanes, in addition to the presence of "(B)" afterwards makes it unclear what constitutes (A) and what constitutes (B).

In response, independent claim 13 has been amended to incorporate Markush language to distinguish between the two reactive monomers (A) and (B). The amendment makes clear that the reactive monomer (B) is selected from either 3-methacryloxypropyltris (trimethylsiloxy)silane or vinyltris(trimethylsiloxy)silane. Hence, the rejection is overcome.

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KAWASE *et al.***3. Rejection of Claims under 35 U.S.C. § 102(b)**

The Office Action rejected claims 14 as being anticipated by U.S. Patent No. 5,998,501 ("Tsutsumi *et al.*"). The Office Action maintained the rationale noted in the previous office action and continued that Applicants' traversal was not persuasive. In particular, the Office Action argued that the limitation of imparting flow and leveling properties to a water based coating is merely part of the preamble and therefore fails to lend any patentable weight. The Office Action also seemed to argue that the limitation is only related to the purpose or intended use of the invention and hence, has no significance with respect to claim construction.

However, that assessment is incorrect. It is well settled law, that a reference cannot anticipate method claims where the claims are drawn to a new method of using an "old" composition. *See Rohm and Haas Company v. Dawson Chemical Company, Inc. et al.*, 217 USPQ 515 (D.C. S. Texas 1982) (citing *In re Shetty*, 566 F.2d 81, 195 USPQ 753 (C.C.P.A. 1977); *In re Legator*, 352 F.2d 377, 147 USPQ 322 (C.C.P.A. 1965).

In any case, claim 14 is canceled without disclaimer or prejudice. Hence, the rejection is moot.

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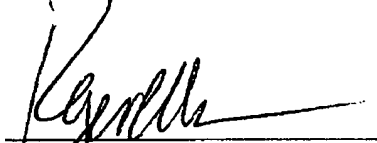
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CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to allow the pending claims. Favorable action with an early allowance of the claims pending is earnestly solicited.

Respectfully submitted,

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